

REMARKS/ARGUMENTS

This Amendment and the following remarks are intended to fully respond to the Office Action mailed June 17, 2004. In that Office Action, claims 1-3, 5-12, 16-21, 23-30, and 33-49 were examined, and all claims were rejected. More specifically, claims 33-36 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; claims 1-2, 5, 7-8, 11, 12, 16-20, 23, 25, 26, 29, 30, 34-37, 40, 41, 44, 45, and 47-49 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wolf et al. (USPN 5,818,447); and claims 3, 9, 10, 21, 27, 28, 42 and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolf et al. in view of Hu et al. (USPN 5,748,188). Reconsideration of these objections and rejections, as they might apply to the original and amended claims in view of these remarks, is respectfully requested.

In this Response, claims 33-36 have been amended. No claims have been canceled. No new claims have been added. Therefore, claims 1-3, 5-12, 16-21, 23-30, and 33-49 remain present for examination.

Drawings

FIG. 2 stands objected to under 37 CFR 1.83(a), as the Examiner states that “The drawings must show every feature of the invention specified in the claims. Therefore, the details of the user interface 104 in Figure 2 must be shown or the feature(s) canceled from the claim(s).” These Figures have not been amended herein because Applicant respectfully asserts the details of user interface 104 are unnecessary under 35 U.S.C. § 113 and 37 CFR 1.83(a).

With regard to drawing requirements, 35 U.S.C. § 113 states that “The applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented.” Further, 37 CFR 1.83(a) states that “conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box).” Applicant respectfully asserts that user interface 104 is a very common element of software application programs, and that the drawing of such a conventional feature is not essential for the understanding of the claimed subject

matter, and thus a labeled rectangular box is sufficient in this case. For this reason, the objection should be withdrawn, since the details of the user interface are not claimed.

Claim Rejections - 35 U.S.C. § 112

Claims 33-36 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 33-36 have been amended above to correct a typographical error. In light of this amendment, it is believed that the rejections under 35 USC §112 has been obviated. Therefore, the Applicant respectfully requests withdrawal of the rejections.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 2, 5, 7, 8, 11, 12, 16-20, 23, 25, 26, 29, 30, 34-37, 40, 41, 44-45, and 47-49 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Wolf et al. (USPN 5,818,447, hereafter “Wolf”). Applicant respectfully traverses the Examiner’s rejections under 35 U.S.C. § 102(e), on the grounds that Wolf does not anticipate the present invention because it does not disclose, explicitly or implicitly, each and every limitation of the pending claims. More specifically, Wolf does not disclose coding an interactive control for a pre-selected portion, inserting the coded interactive control into an e-mail message with a coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion, or sending the coded pre-selected portion of the document and the interactive control to the recipient via electronic mail.

Before discussing the rejection of the claims, brief descriptions of Wolf and the present invention are provided.

Wolf discloses the use of a container object and a server object to display or edit an email message. The container object includes a view port in which the server object renders the body of the email message, which allows the formatting and editing features of the server object to be applied to the body of the email message. The container object is embedded within the email program, and serves as the interface between the server object and the email client. The container object provides controls and functionality associated with both an email program and another application (such as a word processor, spreadsheet, or desktop publishing application),

and allows the power and versatility of these applications to be leveraged when writing, editing and viewing emails inside an email program.

In contrast, the present invention is directed to sending a pre-selected portion of an electronic document to a mail client or recipient via email. The module includes a publish engine for receiving a sender's pre-selected portion of a document from an application program. The publish engine launches an electronic mail application program, and inserts the coded pre-selected portion into an email message. The publish engine may also code an interactive control for the pre-selected portion, and insert the coded interactive control into the email message so that the mail client or recipient can apply the interactive control to the pre-selected portion. This enables the mail client or recipient to view and manipulate the pre-selected portion with functionality similar to that available to the sender. For example, a sender could send a spreadsheet document with interactive controls, which would allow the recipient to manipulate the spreadsheet within its original formatting, without having to open another application program.

With these differences in mind, it will become clear as discussed below how the claims differ from the Wolf reference.

Under 35 U.S.C. § 102, a reference must show or describe each and every element claimed in order to anticipate the claims. *Verdegaal Bros. V. Union Oil Co. of California* 814 F.2d 628 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."). Since Wolf does not disclose coding an interactive control for a pre-selected portion, inserting the coded interactive control into an e-mail message with a coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion, or sending the coded pre-selected portion of the document and the interactive control to the recipient via electronic mail, Wolf cannot, as a matter of law, anticipate claims 1, 19, and 37. Further, dependent claims 2, 5, 7-8, 11-12, 16-18, 20, 23, 25-26, 29-30, 34-36, 40-41, 44-45, and 47-49 depend directly or indirectly from said independent claims, such that these dependent claims should also be allowed over Wolf. Reconsideration is thus respectfully requested.

Claim Rejections – 35 U.S.C. § 103

Claims 3, 9, 10, 21, 27, 28, 38, 42, and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolf et al. in view of Hu et al. (USPN 5,748,188, hereafter “Hu”). Applicant respectfully traverses the § 103 rejections, as the Examiner has failed to establish a prima facie case of obviousness. In order to establish a prima facie case, the references must show that the cited references teach or suggest each of the elements of the claimed invention (MPEP § 706.02(j) and 2142-43). With respect to the cited references, all elements of the independent claims are neither taught nor suggested.

Wolf, as discussed above, relates to the use of a container object and a server object to display or edit an email message. The container object includes a view port in which the server object renders the body of the email message, which allows the formatting and editing features of the server object to be applied to the body of the email message. The container object is embedded within the email program, and serves as the interface between the server object and the email client. The container object provides controls and functionality associated with both an email program and another application (such as a word processor, spreadsheet, or desktop publishing application), and allows the power and versatility of these applications to be leveraged when writing, editing and viewing emails inside an email program.

In contrast, the Hu reference relates to a hypertext data processing system wherein graphical data is sent from a server to a client computer using extensions to the Hypertext Markup Language (HTML). The client computer parses the graphical data and formulates an object representative of the graph to display. The object is passed to a graph server, which displays the graph.

The combination of Wolf and Hu simply does not teach or suggest each of the elements of the claimed invention. Neither Wolf nor Hu, alone or in combination, disclose or suggest coding an interactive control for a pre-selected portion, inserting the coded interactive control into an e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion, or sending the coded pre-selected portion of the document and the interactive control to a recipient via electronic mail as recited in

claims 1, 19 and 37 and thus incorporated in dependent claims 3, 9-10, 21, 27-28, 38, and 42-43. Reconsideration of the § 103(a) rejections is therefore respectfully requested.

Since the remarks above are believed to distinguish over the applied reference, any remaining arguments supporting the claim rejections are not acquiesced to because they are not addressed herein.

Conclusion

It is believed that no further fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

In light of the above remarks and amendments, it is believed that the application is now in condition for allowance, and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,

Dated: _____

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